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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,856	06/08/2001	Nobuyuki Tonegawa	862.C2256	9352

5514 7590 09/22/2004

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

LIM, KRISNA

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,856

Applicant(s)

TONEGAWA, NOBUYUKI

Examiner

Krisna Lim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9, 10, 19 and 20 is/are allowed.
- 6) ☒ Claim(s) 1, 12, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 2-8, 11 and 13-18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____

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1. Claims 1-22 are presented for examination.
2. The title of the invention is neither descriptive nor precise. A new title is required which should include, using twenty words or fewer, claimed features that differentiate the invention from the Prior Art. The title should reflect the gist of or the improvement of the present invention.
3. An invention may be patented only if it falls within one of the four statutory classes of subject matter of 35 U.S.C. 101. *Kewanee Oil Co. V. Bicron Corp.*, 416 U.S. 470, 483, 181 USPQ 673, 679 (1974). The CCPA stated that "any process, machine, manufacture, or composition of matter constitutes statutory subject matter unless it falls within a judicially determined exception of section 101." *In re Pardo*, 684 F.2d 912, 916, 214 USPQ 673, 677 (CCPA 1982). The claims are directed to non-statutory subject matter because the claimed subject matter:
 - (A) does not fall within any of the four statutory classes of 35 U.S.C. 101; and/or
 - (B) falls, by analogy, within the printed matter exception to 101 or within a new exception to computer programs per se.
4. (A) In order to determine if the claimed invention falls within any of the four statutory classes, one must determine if the mere labeling by the preamble is sufficient to allow the claim to pass muster. The applicant has attempted to categorize his invention into one of the statutory classes by merely labeling the invention in the preamble as an article of manufacture (a program product) or as a storage device (storage medium). However, it is clear that the body of the claim is directed to computer code (codes of) and not directed to a computer implemented process or apparatus since no computer is claimed. The claims are not directed to a computer implemented

process, i.e., to a series of steps performed by a computer, which processes were held by the CCPA to constitute statutory subject matter unless within a judicially determined exception to 101. See "Patentable Subject matter -- Mathematical Algorithms and Computer Programs," 1106 off. Gaz. Pat. Office 5, 10-11, (Sept 5, 1989); In re Gelnovatch, 595 F.2d 32, 44, 201 USPQ 136, 147 (CCPA 1979) (What is usually at issue "is not the 'program' i.e., the software, but the process steps that the software directs the computer to perform"); In re Johnson, 589 F.2d 1070, 10891, n.12, 200 USPQ 199, 210 n.12 (CCPA 1978). Instead, the claims are expressly directed to a computer program or "software" intended to run on a computer, albeit claimed in functional terms as "means in memory for " rather than as lines of code, which may or may not be associated with structure.

5. Non-statutory subject matter cannot be automatically converted into statutory subject matter merely by broadly labeling the claim as an "article of manufacture" or by drafting the claims with token references to something that is statutory subject matter, such as "A program product, in computer readable form, for use in a data processing system"; this form of draftsmanship would amount to elevating over substance.

6. Codes in a storage medium, separated from the computer, is merely a blueprint or abstract ideas in code form UNTIL interpreted by the computer. Blueprints, a form of printed matter, are not patentable - they are merely guidance from which a patentable device may be developed when the information from the blueprint is taken from the blueprint and implemented.

7. Thus, claims 21 and 22 are rejected under 35 U.S.C. 101 because they are directed to non-statutory subject matter.

Claims 21 and 22 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

8. In order to overcome the above rejection, applicant is advised to change, at line 1 of claims 21 and 22, "a program" to "a computer implemented program" and at line 3 of claims 21 and 22, "program" to "computer implemented program".

9.. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10.. Claims 1, 12, 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schreiber et al. [U.S. Patent No. 5,970,491].

11. Schreiber et al. disclose (e.g., see Fig. 2) the invention substantially as claimed. Taking claims 1, 12, 21 and 22 as exemplary claims, the reference disclosed a communication method (see Fig. 2) comprising:

- a) a reception step of receiving electronic mail data (208 of Fig. 2);
- b) a determination step of determining whether or not the electronic mail data received in the reception steps contains data which cannot be handled by a communication apparatus (Is message deliverable at steps 210 and 214 of Fig. 2);
- c) a step of analyzing the electronic mail data (message) and determining whether or not the electronic mail data is error notification mail data for notifying a user

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(status rendezvous procedure 220 of Fig. 2) of a transmission error (message is not deliverable at steps 210 and 214 of Fig. 2);

d) a step of inhibiting transfer (N step after determined that the message is not deliverable at steps 210 and 214 of Fig. 2) or storage of the received electronic mail data when it is determined in the determination (210 and 214) step that the received electronic mail data (message) contains data which cannot be handled.

12. While at col. 5 (lines 25-41) Schreiber et al. disclose that the message is not deliverable because the gateway 108 is down or the destination address for the intended recipient is not valid, or for various other reasons (e.g., see col. 5, line 28). Schreiber, however, does not explicitly mention what are those various reasons. Thus, it would have been obvious to one of ordinary skill in the art to recognize that such various reasons that the message can not be delivered could be a matter of design choices because those various reasons could be the amount of message would be too big, or the system would be too small to handle the amount of message, etc.

13. Claims 9-10 and 19-20 are allowed.

14. Claims 2-8, 11 and 13-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references are cited in the Form PTO-892 for the applicant's review.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Krisna Lim whose telephone number is (703) 305-9672. The examiner can normally be reached on Monday-Friday from 7:30 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Glenton Burgess, can be reached at (703) 305-4772. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [glen.burgess@uspto.gov].

All Internet e-mail communication will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirement of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Office Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

KI

September 18, 2004



KRISNA LIM
PRIMARY EXAMINER